

REMARKS

Forty-two claims were originally filed in the present Application. Claims 1-20 and 22-40 stand rejected under 35 U.S.C. §112, claims 1-6, 21-26, and 41-42 stand rejected under 35 U.S.C. §102, and claims 7-18 and 27-38 stand rejected under 35 U.S.C. §103. Claims 20 and 40 are objected to, but would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Claims 1, 5, 9, 20-21, and 22-41 are amended herein. In addition, new claims 43-47 are added herein. Reconsideration of the present Application in view of the foregoing amendments and the following remarks is respectfully requested.

Rejections under 35 U.S.C. §112, Second Paragraph

In paragraph 2 of the Office Action, the Examiner indicates that claims 1-20 and 22-40 are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner points to various informalities in claims 1, 5, 22, and 25 as grounds for the foregoing rejections under 35 U.S.C. §112. Applicant therefore herein amends claims 1, 5, 9, and 22-40 in order to more clearly recite and claim the present invention.

In view of the foregoing remarks and amendments, Applicant believes that the Examiner's rejections are addressed, and respectfully requests that the rejections under 35 U.S.C. §112, second paragraph be withdrawn so that claims 1-20 and 22-40 may issue in a timely manner.

35 U.S.C. § 102(e)

In paragraph 4 of the Office Action, the Examiner rejects claims 1-6, 21-26, and 41-42 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,929,849 to Kikinis (hereafter Kikinis). The Applicant respectfully traverses these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicant submits that Kikinis fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1, 21, and 41, Applicant responds to the Examiner’s §102 rejection as if applied to amended independent claims 1, 21, and 41. Independent claims 1, 21, and 41 are now amended to recite that “*said video data and said page data are simultaneously shown on a display device, said video data being displayed within a video window*” which are limitations that are not taught or suggested either by the cited reference, or by the Examiner’s citations thereto. The foregoing amendments to claims 1, 21, and 41 are supported by the dependent claims, including claims 9-12 and 19-32.

Applicant respectfully submits that Kikinis teaches away from Applicant’s disclosed and claimed invention. Kikinis repeatedly describes initially displaying video information full-screen on a display monitor, and then accessing a WEB

page that "may take up the entire display, or may be displayed as a movable and adjustable window on the display monitor" (at column 3, lines 37-40, again at column 3, lines 57-60, and yet again at column 4, lines 47-49). Kikinis therefore utilizes a window area for inserting *webpage data* into video programming.

In direct and opposite contrast, Applicant's invention utilizes a video window for inserting video data into displayed page data from a source such as the Internet. Applicant submits that Kikinis nowhere teaches or suggests a "video window" as described and claimed by Applicant. Applicant therefore submits that the rejections under 35 U.S.C. §102 are improper, and respectfully requests reconsideration and allowance of amended independent claims 1, 21, and 41 so that these claims may issue in a timely manner.

With regard to claim 41, "means-plus-function" language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are discussed above. Applicant therefore incorporates those remarks by reference with regard to claim 41. In addition, the Courts have frequently held that "means-plus-function" language, such as that of claim 41, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material or acts described in the specification*, and equivalents thereof.

Applicant respectfully submits that, in light of the substantial differences between the teachings of Kikinis and Applicant's invention as disclosed in the Specification, claim 41 is therefore not anticipated or made obvious by the teachings of Kikinis. Applicant specifically directs the Examiner's attention to

Applicant's discussion of FIGS. 5-10 (Specification, page 11, line 8 through page 17, line 22) which describes in detail the Applicant's claimed "means for manipulating said video data and said page data"

Because a rejection under 35 U.S.C. §102 requires that each and every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Kikinis to identically teach or suggest the claimed invention, including, but not limited to that "*said video data and said page data are simultaneously shown on a display device, said video data being displayed within a video window,*" Applicant respectfully requests reconsideration and allowance of claims 1-42 so that these claims may issue in a timely manner.

35 U.S.C. § 103

In paragraph 6 of the Office Action, the Examiner rejects claims 7-18 and 27-38 under 35 U.S.C. § 103 as being unpatentable over Kikinis in view of U.S. Patent No. 5,845,299 to Arora et al. (hereafter Arora). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicant respectfully traverses the Examiner's assertion that modification of the device of Kikinis according to the teachings of Arora would produce the claimed invention. Applicant submits that Kikinis in combination with Arora fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicant also submits that neither Kikinis nor Arora contain teachings for combining the cited references to produce the Applicant's claimed invention. The Applicant therefore respectfully submits that the obviousness rejections under 35 U.S.C §103 are improper.

As previously discussed above with reference to independent claims 1, 21, and 41, Applicant submits that Kikinis utilizes a window area in a manner that is directly opposite to the techniques disclosed and claimed by Applicant. Applicant hereby incorporates the foregoing remarks and arguments by reference. Applicant therefore submits that Kikinis teaches away from Applicant's invention. A prior art reference which teaches away from the presently claimed invention is "strong evidence of nonobviousness." In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987).

With regard to claims 7 and 27, the Examiner concedes that "[n]either Kikinis nor Arora explicitly disclose copying the page data to create duplicate page data." Applicant concurs. The Examiner then states that "it would have

been obvious to one of ordinary skill . . . to modify Kikinis" It appears that the Examiner is utilizing Official Notice without expressly stating so. Applicant therefore respectfully requests the Examiner to cite specific references in support of these rejections, and failing to do so, to reconsider and withdraw the rejections of claims 7 and 27 so that the present Application may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987).

Applicant submits that the cited references, in combination with the Official Notice, do not suggest a combination that would result in Applicant's invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper. Applicant therefore respectfully requests the Examiner to cite references in support of the Official Notice, and to also indicate where an explicit teaching to combine the cited reference may be found. Alternately, the Applicant requests the Examiner to reconsider and withdraw the rejections of claims 7 and 27 under 35 U.S.C §103.

Furthermore, regarding the Examiner's rejection of dependent claims 2-19 and 22-39, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective

independent claims, are also not identically taught or suggested. Applicant therefore respectfully requests reconsideration and allowance of dependent claims 2-19 and 22-39 so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicant submits that claims 4, 9, 13, 19, 32, 35, and 41-48 are not unpatentable under 35 U.S.C. § 103 over Kikinis in view of Arora, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of claims 7-18 and 27-38 under 35 U.S.C. § 103.

In paragraph 7 of the Office Action, the Examiner rejects claims 19 and 39 35 U.S.C. § 103 as being unpatentable over Kikinis in view of Arora, and further in view of U.S. Patent No. 6,225,541 to Bates et al. (hereafter Bates). The Applicant respectfully traverses these rejections for at least the following reasons.

With regard to claims 19 and 39, the Examiner concedes that “neither Kikinis nor Arora discloses the current reference position is computed by combining a prior reference position and a scroll value.” Applicant concurs. To purported remedy this deficiency, the Examiner cites Bates. The Examiner then concludes that “it would have been obvious to one of ordinary skill in the art to modify Kikinis and Arora by computing the new position base on the prior position as taught by Bates *in order to quickly locate the position.*”

Applicant respectfully submits that a *general restatement of the advantages disclosed by the Applicant* deriving from implementation of the present invention should not act as the required teaching or suggestion to combine cited references

for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

Applicant suggests that merely because certain isolated aspects from cited references produce a beneficial result, this fact alone does not provide the requisite teaching for combining references under 35 U.S.C. §103. Applicant therefore respectfully requests the Examiner to provide citations to specific sections of the cited references that indicate explicit teachings for combining the references.

For at least the foregoing reasons, the Applicant submits that claims 19 and 39 are not unpatentable under 35 U.S.C. § 103 over Kikinis in view of Arora and Bates, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicant therefore respectfully request reconsideration and withdrawal of the rejections of claims 19 and 39 under 35 U.S.C. § 103.

Allowable Subject Matter

In paragraph 8, the Examiner indicates that claims 20 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant therefore amends claims 20 and 40 in independent form including all of the limitations of the base claim and any intervening claims, to thereby place claims 20 and 40 in condition for immediate allowance.

Summary

Applicant submits that the foregoing amendments and remarks overcome the Examiner's objections and rejections under 35 U.S.C. §112, 35 U.S.C. §102, 35 U.S.C. §103. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicant therefore submits that the claimed invention is patentable over the cited art, and respectfully requests the Examiner to allow all claims so that the present Application may issue in a timely manner.

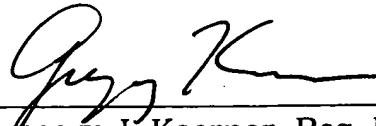
Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version With Markings To Show Changes Made." If there are any questions concerning this amendment, the Examiner is invited to contact the Applicant's undersigned representative at the number provided below.

Respectfully submitted,

Toshiya Fujii

Date: 5/30/02

By:


Gregory J. Koerner, Reg. No. 38,519
SIMON & KOERNER LLP
10052 Pasadena Avenue, Suite B
Cupertino, CA 95014
(408) 873-3943

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In The Claims:

1. (Once Amended) A system for selectively accessing video data and page data, comprising:
a format manager for manipulating said video data and said page data; and
a processor, coupled to said [system,] format manager for controlling said format manager, whereby said video data and said page data are simultaneously shown on a display device, said video data being displayed within a video window.
5. (Once Amended) The system of claim [3] 4 wherein said set top box includes said processor and said format manager.
9. (Once Amended) The system of claim [7] 8 wherein said format manager selectively positions said video tag to vertically locate [a] said video window on said display device.

20. (Once Amended) [The system of claim 19 wherein] A system for selectively accessing video data and page data, comprising:

a format manager for manipulating said video data and said page data,
said format manager copying said page data to create duplicate page
data, inserting a video tag into said duplicate page data, and
selectively positioning said video tag to vertically locate a video
window on a display device, said duplicate page data being scrollable
with reference to said video window on said display device, said
format manager computing a current reference position each time
said duplicate page data is scrolled, said current reference position
being computed by combining a prior reference position and a scroll
value, said scroll value [is] being positive when said duplicate page
data is scrolled down, [and wherein] said scroll value [is] being
negative when said duplicate page data is scrolled upwards; and
a processor, coupled to said format manager for controlling said format
manager, whereby said video data and said page data are
simultaneously shown on said display device.

21. (Once Amended) A method for selectively accessing video data and page data, comprising the steps of:

manipulating said video data and said page data using a format
manager; and

controlling said format manager using a processor, whereby said video data
and said page data are simultaneously shown on a display device, said
video data being displayed within a video window.

22. (Once Amended) The [system] method of claim 21 wherein said page data is obtained from a distributed electronic network and said video data is obtained from a video source.

23. (Once Amended) The [system] method of claim 22 wherein said distributed electronic network is an Internet network.
24. (Once Amended) The [system] method of claim 21 wherein said display device is a television set controlled by a set top box.
25. (Once Amended) The [system] method of claim [23] 24 wherein said set top box includes said processor and said format manager.
26. (Once Amended) The [system] method of claim 25 wherein said set top box is controlled by a wireless remote control device.
27. (Once Amended) The [system] method of claim 21 wherein said format manager copies said page data to create duplicate page data.
28. (Once Amended) The [system] method of claim 27 wherein said format manager inserts a video tag into said duplicate page data.
29. (Once Amended) The [system] method of claim [27] 28 wherein said format manager selectively positions said video tag to vertically locate [a] said video window on said display device.
30. (Once Amended) The [system] method of claim 29 wherein said video tag includes window information for sizing and horizontally positioning said video window.
31. (Once Amended) The [system] method of claim 29 wherein said format manager reformats said duplicated page data to avoid said video window.
32. (Once Amended) The [system] method of claim 29 wherein said processor displays said duplicated page data on said display device.

33. (Once Amended) The [system] method of claim 29 wherein said format manager maintains said video window in a stationary position on said display device.
34. (Once Amended) The [system] method of claim 29 wherein said video window is selectively positionable on said display device.
35. (Once Amended) The [system] method of claim 29 wherein said video window is selectively sizeable on said display device.
36. (Once Amended) The [system] method of claim 29 wherein said duplicate page data is scrollable with reference to said video window on said display device.
37. (Once Amended) The [system] method of claim 36 wherein said format manager computes a current reference position each time said duplicate page data is scrolled.
38. (Once Amended) The [system] method of claim 36 wherein said format manager uses said current reference position as a reference point for locating said video window.
39. (Once Amended) The [system] method of claim 37 wherein said current reference position is computed by combining a prior reference position and a scroll value.

40. (Once Amended) [The system of claim 39] A method for selectively accessing video data and page data, comprising the steps of:

manipulating said video data and said page data using a format manager,
said format manager copying said page data to create duplicate page
data, inserting a video tag into said duplicate page data, and
selectively positioning said video tag to vertically locate a video
window on a display device, said duplicate page data being scrollable
with reference to said video window on said display device, said
format manager computing a current reference position each time
said duplicate page data is scrolled, said current reference position
being computed by combining a prior reference position and a scroll
value, said scroll value [is] being positive when said duplicate page
data is scrolled down, [and wherein] said scroll value [is] being
negative when said duplicate page data is scrolled upwards; and
controlling said format manager using a processor, whereby said video data
and said page data are simultaneously shown on a display device.

41. (Once Amended) A computer-readable medium comprising program instructions for selectively accessing video data and page data by performing the steps of:

manipulating said video data and said page data using a format manager; and

controlling said format manager using a processor, whereby said video data and said page data are simultaneously shown on a display device, said video data being displayed within a video window.

43. (New) A system for selectively accessing video data and page data, comprising:
a format manager for manipulating said video data and said page data,
said format manager providing a video window on a display device
for displaying said video data, said page data being scrollable with
reference to said video window by utilizing a scroll value which is
positive when said page data is scrolled down, and which is negative
when said page data is scrolled upwards; and
a processor configured to control said format manager, whereby said video
data and said page data are simultaneously shown on said display
device.
44. (New) The system of claim 43 wherein said format manager positions a video
tag to vertically locate said video window on said display device.
45. (New) The system of claim 43 wherein said format manager copies said page
data to create duplicate page data for displaying on said display device.
46. (New) The system of claim 43 wherein said format manager computes a
current reference position each time said page data is scrolled.
47. (New) The system of claim 46 wherein said current reference position is
computed by combining a prior reference position and a scroll value.